**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**

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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 07/058,219 | 06/04/87 | MERTEL | X-5747 |

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| EXAMINER | |
|---|---|
| DAVIDSON | |
| **ART UNIT** | **PAPER NUMBER** |
| 115 | 4 |

**DATE MAILED:** 08/17/88

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

**Part II SUMMARY OF ACTION**

1. ☑ Claims 1-22 are pending in the application.
   Of the above, claims 3-10, 13-22 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1, 2, 11, and 12 are rejected.
5. ☐ Claims _____ are objected to.
6. ☑ Claims 1-22 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12 are, drawn to nucleoside compounds, a composition, and method of use, classified in Class 536, subclasses 23, 24 and 26.

II. Claims 13-22 are, drawn to a difluoro -desoxy carbohydrate compound, classified in Class 549, subclass 449.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as species in an intermediate-final product relationship.

> Distinctness is proven for claims in this relationship if the intermediate product is useful other than to make the final product (MPEP 806.04(b), 3rd paragraph), and the species are patentably distinct. (MPEP 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as a compound for treating insects and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

> Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or

admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Irrespective of whichever group applicants elect, applicants are further required under 35 USC 121 (1) to elect an ultimate disclosed species to which claims will be restricted if no generic claim is finally held allowable and (2) to list all claims readable thereon including those subsequently added.

In a telephone conversation with Mr. Bruce Barkley on February 5, 1988, a provisional election was made with traverse to prosecute the invention of group I, the nucleoside species wherein R is the base recited in claim 1, lines 25-30 wherein $R^2$ is hydroxy. Claims 1-2, 11 and 12 are readable on the elected species. All other embodiments are considered patentably distinct and are withdrawn by the examiner under 37 CFR 1.142(b). Accordingly, claims 3-10 and 13-22 are held to be withdrawn from consideration under 37 1.142(b). Affirmation of the election must be made by applicants in responding to this office action.

To facilitate the prosecution of the case, appli-

cants should consider deleting the non-elected subject matter and inserting a subgeneric claim readable on the elected species.

Claims 11 and 12 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 11 is considered unduly broad and beyond the scope of enablement as it would require undue experimentation for the skilled artisan to determine the viral infections against which the instant compounds are effective. The specific virus inhibited by the instant compounds and compositions should be recited in both claims 11 and 12. Claim 12 is considered improper as it fails to specify the use of the composition and effective amount of the active ingredient. See In re Watson, 169 USPQ 11, 20 (C.C.P.A. 1975).

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 as

claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 4,692,434.
This is a double patenting rejection.

Claims 11 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the prior invention as set forth in claims 3 and 4 of U.S. patent no. 4,692,434. Although the conflicting claims are not identical, they are not patentably distinct from each other because the viral infections recited in the claims include the herpes viral infection in the patented claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy Davis whose telephone number is (703) 557-3982.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3920.

wld
DAVIS:pc
3/14/88

ALAN M. SIEGEL
PRIMARY EXAMINER
ART UNIT 123